



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,194	12/20/2001	Manabu Kii	450100-03675	9663
20/999 7590 09/15/2008 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
EXAMINER				
LE, MICHAEL				
ART UNIT		PAPER NUMBER		
2163				
MAIL DATE		DELIVERY MODE		
09/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/027,194

Applicant(s)

KII ET AL.

Examiner

MICHAEL LE

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-9 and 26 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. In view of the BPAI decision filed on July 29, 2008, the Examiner performed and update search of the prior art before allowance. Examiner and Applicant discussed possible amendments to the claims to place them in form for allowance over new prior art, but were unable to reach a solution. PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Summary and Status of Claims

2. This Office Action is in response to the BPAI decision rendered July 29, 2008.
3. Claims 10 and 12-14 are cancelled per Applicant's approval.
4. Claims 1-9 and 26 are pending.
5. Claim 3 is objected to for containing allowable subject matter.

6. Claims 1, 2, 4-9, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Collart et al. (US Patent 6,405,203).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1, 2, 4-9, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Collart et al. (US Patent 6,405,203) (Collart).**

9. In regards to **claim 1**, Collart discloses a service offering system from a server to a terminal device (Collart at fig. 5, elements 550 (server) and 510 (client)), comprising:
- recording means for recording a unique identifier to each of a plurality of package storage media issued (Collart at col. 5, lines 65-7; col. 6, lines 1-10)¹;
 - a database for storing and managing the identifiers (Collart at col. 7, lines 6-8);
 - reading means for reading the recorded identifier from any of said package storage media at said terminal device (Collart at col. 14, lines 1-4);
 - checking means for checking the identifier read by said reading means against said identifiers managed in said database (Collart at col. 14, lines 6-9); and

¹ Burst Cut Area (BCA) is interpreted as the unique identifier.

- c. service offering means for offering a service to said terminal device corresponding to the package storage medium identified by the checked identifier depending on a result of the check by said checking means. Collart at col. 14, lines 39-50.
10. In regards to **claim 2**, Collart discloses a service offering system according to claim 1, wherein said database stores, in correspondence with said identifiers, right information which denotes services available to said storage media identified by said identifiers. Collart at col. 14, lines 18-24, 46-50; col. 19, lines 28-40, 60-7².
11. In regards to **claim 4**, Collart discloses a service offering system according to claim 1, wherein said service offering means offers the service to the storage medium in accordance with the right information which denotes services available to said storage media identified by said identifiers. Collart at col. 14, lines 18-24, 46-50; col. 19, lines 28-40, 60-7.
12. In regards to **claim 5**, Collart discloses a service offering system according to claim 1, further comprising content data storage means for storing a plurality of content data items (Collart at col. 19, lines 30-9); wherein said service offering means allows relevant content data to be downloaded from said content data storing means to the storage medium. Collart at col. 22, lines 13-5.

² The cited portions describe indications that the BCA number (i.e., unique identifier) read at the client is looked up in the database of the server. Upon doing so, the server determines what content or services can be distributed to the user based on the BCA number. Therefore, it seems implicit that the information corresponding the BCA number to the content or services (i.e., right information) is also stored in the database.

13. In regards to **claim 6**, Collart discloses a service offering system according to claim 1, wherein said service offering means allows relevant content data to be updated from the storage medium. Collart at col. 20, lines 66-7; col. 21, lines 1-4³.

14. In regards to **claim 7**, Collart discloses a service offering system from a server to a terminal device (Collart at fig. 5, elements 550 (server) and 510 (client)), comprising:

- a. storage medium issuing means including recording means for recording a unique identifier to each of a plurality of package storage media issued (Collart at col. 5, lines 65-7; col. 6, lines 1-10)⁴;
- b. a management server including a database for storing and managing the identifiers recorded to said package storage media issued by said storage medium issuing means (Collart at col. 7, lines 6-8);
- c. said terminal device including reading means for reading the recorded identifier from any of said package storage media (Collart at col. 14, lines 1-4);
- d. checking means for checking the identifier read by said terminal device against said identifiers managed in said database (Collart at col. 14, lines 6-9); and
- e. a service provider including service offering means for offering a service to said terminal device corresponding to said package storage media depending on a result of the check by said checking means. Collart at col. 14, lines 39-50.

15. In regards to **claim 8**, Collart discloses a service offering system from a server to a terminal device (Collart at fig. 5, elements 550 (server) and 510 (client)), comprising:

³ Data from the DVD is taken and sent to the server to be logged into the database (i.e., update from the storage medium).

⁴ Burst Cut Area (BCA) is interpreted as the unique identifier.

- a. storage medium issuing means including recording means for recording a unique identifier to each of a plurality of package storage media issued (Collart at col. 5, lines 65-7; col. 6, lines 1-10)⁵;
 - b. the server including a database which stores the identifiers (Collart at col. 7, lines 6-8) and retains, in correspondence with said identifiers, right information which denotes services available to said package storage media identified by said identifiers (Collart at col. 14, lines 18-24, 46-50; col. 19, lines 28-40, 60-7)⁶;
 - c. the terminal device including reading means for reading the recorded identifiers from any of said package storage media (Collart at col. 14, lines 1-4); and
 - d. a service provider including service offering means for offering a service to said terminal device corresponding to said package storage media depending on a result of checking the identifier in question against said identifiers managed in said database and according to the right information stored in said database in correspondence with the checked identifier. Collart at col. 14, lines 39-50.
16. In regards to **claim 9**, Collart discloses a service offering system according to claim 8, wherein said service provider includes content data storing means for storing a plurality of content data items (Collart at col. 19, lines 30-9);
- a. wherein said service offering means includes judging means for judging whether or not the corresponding right information indicates permission to download (Collart at

⁵ Burst Cut Area (BCA) is interpreted as the unique identifier.

⁶ The cited portions describe indications that the BCA number (i.e., unique identifier) read at the client is looked up in the database of the server. Upon doing so, the server determines what content or services can be distributed to the user based on the BCA number. Therefore, it seems implicit that the information corresponding the BCA number to the content or services (i.e., right information) is also stored in the database.

col. 22, lines 10-5)⁷, said service offering means further reading relevant content data from said content data storing means and transferring the content data to said terminal device in accordance with the judgment made by said judging means (Collart at col. 22, lines 15-23)⁸; and

b. wherein said terminal device receives the transferred content data and records the received data to the storage medium. Collart at col. 22, lines 13-5.

17. In regards to **claim 26**, Collart discloses a service offering method for offering a service from a server to a terminal device (Collart at fig. 5, elements 550 (server) and 510 (client)), the method comprising the steps of:

- a. recording a unique identifier to each of a plurality of package storage media issued (Collart at col. 5, lines 65-7; col. 6, lines 1-10)⁹;
- b. storing the identifiers into a database (Collart at col. 7, lines 6-8);
- c. reading the recorded identifier from any of said package storage media at said terminal device (Collart at col. 7, lines 47-52; col. 14, lines 1-4);
- d. checking the identifier read from the package storage medium against said identifiers stored in said database (Collart at col. 14, lines 6-8); and
- e. offering a service to said terminal device corresponding to the package storage medium identified by the checked identifier. Collart at col. 14, lines 39-50¹⁰.

⁷ The BCA number is used to look up the retailer, which in turn is used to look up available downloads. This "lookup" is interpreted as a judging means because if there is no match for the BCA number, then the user does not have permission to download.

⁸ If the lookup of the BCA is successful, the download information is sent to the user (i.e., transferring content data to said terminal device in accordance with the judgment).

⁹ Burst Cut Area (BCA) is interpreted as the unique identifier.

¹⁰ The web server acts upon the posted information (the BCA number) and sends a unique URL to the user (i.e., offering a service).

Allowable Subject Matter

18. **Claim 3** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

19. The following are prior art made of record and not relied upon but is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Le whose telephone number is 571-272-7970. The examiner can normally be reached on Mon-Thurs : 9:30am-6pm, Fri: 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael Le/
Examiner, Art Unit 2163

Application/Control Number: 10/027,194
Art Unit: 2163

Page 9

/don wong/
Supervisory Patent Examiner, Art Unit 2163